

**PATTERSON &  
SHERIDAN, LLP**  
ATTORNEYS AT LAW

**RECEIVED  
CENTRAL FAX CENTER**

**FEB 27 2006**

3040 Post Oak Blvd, Suite 1500  
Houston, TX 77056-6582  
TEL 713.623.4844  
FAX 713.623.4846

## FACSIMILE COVER SHEET

**DATE:** February 27, 2006

**FILE NO:** ROC920010074US1 (IBMK10074)

**TO:** MAIL STOP APPEAL BRIEF - PATENTS  
Examiner Etienne P. LeRoux

**FAX NO:** 1-571-273-8300

**COMPANY:** USPTO

**FROM:** Gero G. McClellan / David M. Magness

**PAGE(S) with cover:** 21

**ORIGINAL TO FOLLOW?** ☐ YES ☒ NO

**RE:**

**TITLE:** Method of Searching for Text in Browser Frames

**U.S. SERIAL NO.:** 09/882,917

**FILING DATE:** June 15, 2001

**INVENTOR(S):** Cary Lee Bates et al.

**EXAMINER:** Etienne P. LeRoux

**GROUP ART UNIT:** 2161

**CONFIRMATION NO.:** 9773

Attached for the above-referenced application are:

Appeal Brief

### CONFIDENTIALITY NOTE

The document accompanying this facsimile transmission contains information from the law firm of Patterson & Sheridan, L.L.P. which is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution or use of the contents of this faxed information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

404487\_1

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

**RECEIVED**  
**CENTRAL FAX CENTER**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

FEB 27 2006

In re Application of:  
Cary Lee Bates et al.

Serial No.: 09/882,917

Confirmation No.: 9773

Filed: June 15, 2001

For: Method of Searching for Text in  
Browser Frames

Group Art Unit: 2161

Examiner: Etienne P. LeRoux

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATE OF MAILING OR TRANSMISSION**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to fax number 571-273-8300 to the attention of Examiner Etienne P. LeRoux, on the date shown below:

February 27, 2006  
Date

*David M. Magness*  
David M. Magness

Dear Sir:

**APPEAL BRIEF**

Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 2161 dated August 19, 2005, finally rejecting claims 1-26. The final rejection of claims 1-26 is appealed. This Appeal Brief is believed to be timely since facsimile transmitted by the due date of February 27, 2006, as set by mailing a Notice of Appeal on December 27, 2005. Please charge the fee of \$500.00 for filing this brief to Deposit Account No. 09-0465/ROC920010074US1.

441436\_1

Page 1

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

## **TABLE OF CONTENTS**

1.	Identification Page.....	1
2.	Table of Contents .....	2
3.	Real Party in Interest .....	3
4.	Related Appeals and Interferences .....	4
5.	Status of Claims .....	5
6.	Status of Amendments .....	6
7.	Summary of Claimed Subject Matter .....	7
8.	Grounds of Rejection to be Reviewed on Appeal .....	8
9.	Arguments .....	9
10.	Conclusion .....	15
11.	Claims Appendix .....	16
12.	Related Proceedings Appendix .....	20

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

**Real Party in Interest**

The present application has been assigned to International Business Machines Corporation, Armonk, New York.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

### **Related Appeals and Interferences**

Applicant asserts that no other appeals or interferences are known to the Applicant, the Applicant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

### **Status of Claims**

Claims 1-26 are pending in the application. Claims 1-25 were originally presented in the application. Claims 1-26 stand finally rejected as discussed below. The final rejections of claims 1-26 are appealed. The pending claims are shown in the attached Claims Appendix.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

### **Status of Amendments**

All claim amendments have been entered by the Examiner. No amendments to the claims were proposed after the final rejection.

### Summary of Claimed Subject Matter

Claimed embodiments of the invention (see, e.g., Claim 1) provide a method of formatting an electronic document comprising at least two frames each containing searchable text. See, e.g., Figure 2, Item 200, 204A-C; Pg. 3, Para. 0037. The method includes receiving a response containing the electronic document (see, e.g., Figure 2, Item 200, 204A-C; Pg. 3, Para. 0038, 0040), automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames (see, e.g., Figure 3, Item 308, 310, 314, 316; Pg. 3, Para. 0040-0041), and rendering the electronic document for display (see, e.g., Figure 3, Item 312; Pg. 4, Para. 0042), wherein the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame, and wherein, absent a command from the user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame. See, e.g., Figure 3, Item 318, 316, 320, 322, 324; Pg. 4, Para. 0043-0044.

Claimed embodiments of the invention (see, e.g., Claim 10) also provide a computer readable medium, comprising a network navigation program which, when executed by a processor, causes steps to be performed. See, e.g., Figure 1, Item 122, 128, 132, 140; Pg. 2, Para. 0021, 0024-0028. The steps include parsing a response containing an electronic document formatted with at least two frames each containing searchable content (see, e.g., Figure 2, Item 200, 204A-C; Pg. 3, Para. 0038, 0040), and automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame. See, e.g., Figure 3, Item 308, 310, 314, 316; Pg. 3, Para. 0040-0041.

Claimed embodiments of the invention (see, e.g., Claim 21) also provide a computer readable medium comprising a digital document. See, e.g., Figure 1, Item 144, 147, 149; Pg. 3, Para. 0029. The digital document includes (i) a format code segment which, when executed by a processor configured with a program, formats the digital document with at least two frames containing searchable content (see, e.g., Figure 1, Item 128, 132, 140; Figure 3, Item 200, 204A-C; Pg. 3, Para. 0031-0037), and



PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

(ii) a default search frame code segment which, when executed by the processor, designates one of the two frames as a default search frame based on a pre-existing specification of the default search frame. See, e.g., Figure 2, Item 200, 204A-C, 206; Figure 3, Item 308, 310; Pg. 3, Para. 0034, 0036-0037, 0039-0040.

Claimed embodiments also describe (see, e.g., Claim 25) the default search frame is configured to be highlighted when rendered by the program. See, e.g., Figure 2, Item 200, 204A-C, 206; Pg. 3, Para. 0037.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

### Grounds of Rejection to be Reviewed on Appeal

1. Claims 1-4, 6, 10-13, 15, 18-23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,044,387 issued to *Angiulo et al.* (hereinafter *Angiulo*).
2. Claims 5, 7, 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,909,837 issued to *Unger*.
3. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,658,626 as issued to *Aiken*.
4. Claims 9, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 5,388,993 issued to *McKiel et al.* (hereinafter *McKiel*).

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

## **ARGUMENTS**

**1. The Examiner errs in rejecting Claims 1-4, 6, 10-13, 15, 18-23 and 26 under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,044,387 Issued to *Angiulo*.**

### *The Applicable Law*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim... In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

### *The Cited Reference*

*Angiulo* describes single command editing of multiple files. See Abstract. A spell check or a find and replace editing operation may be implemented on a plurality of documents and is initiated from a single dialog box. See *id.*

### *The Examiner's Argument*

With respect to claim 1, and the claims that depend therefrom, *Angiulo* does not disclose "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames". The Examiner argues that *Angiulo* discloses automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames at Fig 3, Item 110 and Col. 5, Lines 27-43. See *Final Office Action Dated August 19, 2005*

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

(hereinafter *Final Office Action*), Page 2, Para. 4. However, the cited sections are in fact directed to checking the spelling of pages in an editor, as clearly indicated by both the title of the dialog box 100 in Fig. 3 and the cited text in Col. 5. The cited section states that the user may check the spelling of all pages on a website or only selected pages. See Fig 3; Col. 5, Lines 27-43. The section does not describe frames and does not state that the pages being checked for spelling are frames, nor does the cited section mention searching. Thus, the cited section does not describe automatically designating one of at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames.

With respect to claims 10 and 21, and the claims that depend therefrom, Angiulo does not disclose "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame". The Examiner argues that Angiulo discloses automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame at Fig 9, Steps 192, 196 and 198 and Col 9, Lines 15-25. *Final Office Action*, Pg. 3-4, Para. 5; Pg. 5, Para. 3. However, the cited passage is in fact directed to logic implemented when carrying out an editing operation. See Col. 8, Lines 64-66. The editing operation can be either a spell check of documents or a find/replace operation. See Col. 8, Line 66 – Col. 9, Line 2. If the user elects to conduct an editing operation on all files on the web, a list of all of the files on the web site is built. See Fig. 9, Item 192; Col. 9, Lines 2-10. A counter or variable 'n' is then initialized to 0, and the editing operation is performed beginning with file 'n'. See Fig. 9, Items 190, 192, 194, 196, 198, 200; Col. 9 Lines 12-18. The cited figure and section do not describe that the documents being edited are frames. See *id.* Furthermore, because the cited section does not describe that the documents being edited are frames, the cited section does not describe a designation of a default search frame. See *id.* Accordingly, the reference does not describe "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame". Withdrawal of the rejection is respectfully requested.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

*The Examiner's Response to Applicants' Arguments*

In the Examiner's *Advisory Action* dated November, 11, 2005 (hereinafter, *Advisory Action*), the Examiner responds to Applicants arguments, stating that a frame is a rectangular area in which text or graphics can appear and citing to *Angiulo* at Fig. 3, Item 110 and Col. 5, Lines 27-43. *Advisory Action*, Pg. 3, Para. 1. *Angiulo* identifies Item 110 of Figure 3 as a "check box". A check box 110, as well known to those skilled in the art, is not a frame, nor does the "check box" 110 in *Angiulo* contain any text or graphics as asserted by the Examiner. See Figure 3, Item 110. Furthermore, the pending claims (See, e.g., Claim 1) describe "the designated default search frame of the displayed electronic document", and with respect to the check box 110 in Figure 3, the Examiner has not identified any "displayed electronic document" of which the "check box" 110 is a part. Also, with respect to the cited section (Col. 5, Lines 27-43), the cited section merely states that the check box 110 provides the user with an option to add a task of reviewing pages that appear to include misspellings to a list. There is no description in the cited section that either the check box 110 or such pages are a designated default search frame of a displayed electronic document as claimed. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner also states that the cited "check box" 110 and section of *Angiulo* describe a "default" frame. *Advisory Action*, Pg. 3, Para. 1. Applicants first note that the Examiner has not used the language of Applicants' claims in stating that the reference teaches a "default" frame, and thus, has improperly construed Applicants' claims in making the rejection. *Id.* Here, the claims refer, for example, to "a pre-existing specification of the default search frame". The Examiner has not provided an example of a "pre-existing specification" in the cited sections of *Angiulo*, and furthermore, the Examiner has not provided an example of a "default search frame". As described above, the cited section does not refer to any frame, and furthermore, the cited section is not directed towards *searching*. See Col. 5, Lines 27-43. Instead, the cited section (Col. 5, Lines 27-43) is directed to spell checking, and not searching. Accordingly, withdrawal of the rejection is respectfully requested.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

**2. The Examiner errs in rejecting Claims 5, 7, 14 and 24 under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,909,837 issued to *Unger*.**

Claims 5, 7, 14 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,909,837 issued to *Unger*. In rejecting claims 5, 7, 14 and 24, the Examiner incorporates the arguments presented above with respect to *Angiulo*. As described above, Appellants believe that the rejection of the claims with respect to *Angiulo* has been overcome. Accordingly, the combination of *Angiulo* and *Unger* does not teach, show, or suggest the claimed subject matter. Therefore, the claims are believed to be allowable and Applicants respectfully request withdrawal of the rejection.

**3. The Examiner errs in rejecting Claims 8 and 16 under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,658,626 as issued to *Aiken*.**

Claims 8 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,658,626 as issued to *Aiken*. In rejecting claims 8 and 16, the Examiner incorporates the arguments presented above with respect to *Angiulo*. As described above, Appellants believe that the rejection of the claims with respect to *Angiulo* has been overcome. Accordingly, the combination of *Angiulo* and *Aiken* does not teach, show, or suggest the claimed subject matter. Therefore, the claims are believed to be allowable and Applicants respectfully request withdrawal of the rejection.

**4. The Examiner errs in rejecting Claims 9, 17 and 25 under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 5,388,993 issued to *McKiel*.**

Claims 9, 17 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 5,388,993 issued to *McKiel*. In

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

rejecting claims 9, 17 and 25, the Examiner incorporates the arguments presented above with respect to *Angiulo*. As described above, Appellants believe that the rejection of the claims with respect to *Angiulo* has been overcome. Accordingly, the combination of *Angiulo* and *McKiel* does not teach, show, or suggest the claimed subject matter. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Furthermore, with respect to the rejection of claim 25, the Examiner states that "the combination of *Gamon* and *Angiulo* discloses the elements of claim 21" and that "the skilled artisan would have been motivated to improve the invention of the combination of *Gamon* and *Angiulo*". See *Final Office Action*, Pg. 10, Para. 3. However, as stated in *Applicants' Response to Office Action Dated July 15, 2005* (See Pg. 6, Para. 7), *Gamon* and the present invention, at the time the present application was made, were owned by the same entity, or subject to an obligation of assignment to the same entity, as shown in *Applicants' Statement of Common Ownership Submitted July 15, 2005*. Under 35 U.S.C. § 103(c), the *Statement of Common Ownership* removes *Gamon* as a reference under 35 U.S.C. § 102(e). Therefore, Applicant respectfully requests that the rejection be withdrawn.

Therefore, the claims are believed to be allowable and Applicants respectfully request withdrawal of the rejections.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

### CONCLUSION

The Examiner errs in rejecting pending claims 1-26 as described above. Accordingly, withdrawal of the rejection and allowance of all claims is respectfully requested.

Respectfully submitted, and  
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan  
Registration No. 44,227  
Patterson & Sheridan, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Appellant(s)



**CLAIMS APPENDIX**

1. (Previously Presented) A method of formatting an electronic document comprising at least two frames each containing searchable text, comprising:  
receiving a response containing the electronic document;  
automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames; and  
rendering the electronic document for display; wherein the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein, absent a command from the user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame.
2. (Original) The method of claim 1, wherein the electronic document is a web page, wherein the response is received from the Internet and wherein at least the automatically designating and rendering are performed by a browser.
3. (Original) The method of claim 1, wherein automatically designating occurs one of before rendering and after rendering.
4. (Original) The method of claim 1, wherein automatically designating occurs without an explicit selection of the default search frame by a user.
5. (Original) The method of claim 1, wherein automatically designating comprises parsing the response to locate a default search frame identifier.
6. (Previously Presented) The method of claim 1, wherein automatically designating comprises selecting from the at least two frames a frame previously

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

selected for a content search, wherein the frame was previously selected during a previous visit to the electronic document.

7. (Original) The method of claim 1, wherein automatically designating comprises selecting from the at least two frames according to an attribute of the at least two frames.

8. (Original) The method of claim 1, wherein automatically designating comprises one of selecting from the at least two frames a frame containing a greater amount of content and selecting a largest frame from the at least two frames.

9. (Original) The method of claim 1, further comprising highlighting the default search frame.

10. (Previously Presented) A computer readable medium, comprising a network navigation program which, when executed by a processor, causes steps comprising:  
parsing a response containing an electronic document formatted with at least two frames each containing searchable content; and  
automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame.

11. (Original) The computer readable medium of claim 10, wherein automatically designating is performed using information contained in at least one of the electronic document and a data structure stored locally on a machine executing the network navigation program.

12. (Original) The computer readable medium of claim 10, wherein automatically designating occurs without an explicit selection of the default search frame by a user.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

13. (Original) The computer readable medium of claim 10, wherein the electronic document is a hypertext markup language (HTML) Web page and the network navigation program is a Web browser.

14. (Original) The computer readable medium of claim 10, wherein automatically designating comprises parsing the response to locate a default search frame tag.

15. (Original) The computer readable medium of claim 10, wherein automatically designating comprises accessing a data structure containing data representing a previous selection of one of the at least two frames.

16. (Original) The computer readable medium of claim 10, wherein automatically designating comprises at least one of selecting from the at least two frames according to an attribute of the at least two frames, selecting from the at least two frames a frame containing a greater amount of content and selecting a largest frame from the at least two frames.

17. (Original) The computer readable medium of claim 10, further comprising highlighting the default search frame.

18. (Original) The computer readable medium of claim 10, further comprising rendering the electronic document for display.

19. (Original) The computer readable medium of claim 18, wherein automatically designating occurs one of before rendering and after rendering.

20. (Original) The computer readable medium of claim 18, wherein at least the automatically designating and rendering are performed by a browser.

21. (Previously Presented) A computer readable medium comprising a digital document comprising (i) a format code segment which, when executed by a processor

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

configured with a program, formats the digital document with at least two frames containing searchable content and (ii) a default search frame code segment which, when executed by the processor, designates one of the two frames as a default search frame based on a pre-existing specification of the default search frame.

22. (Original) The computer readable medium of claim 21, wherein the program is a browser and the default search frame code segment is an HTML tag.

23. (Original) The computer readable medium of claim 21, wherein at least one of the format code segment and the default search frame code segment is hypertext markup language (HTML).

24. (Original) The computer readable medium of claim 21, wherein the default search frame code segment is an attribute of a FRAMESET tag.

25. (Original) The computer readable medium of claim 21, wherein the default search frame is configured to be highlighted when rendered by the program.

26. (Previously Presented) The method of claim 1 further comprising:  
receiving a request for a text search to be performed; and  
as a result of the automatic designation, initiating the text search in the default search frame as opposed to any of the other at least two frames.

PATENT  
Atty. Dkt. No. ROC920010074US1  
PS Ref. No.: IBMK10074

## **RELATED PROCEEDINGS APPENDIX**

No copies of decisions rendered by a court or the Board in the related appeal or interference listed on page 4 of this Brief are included as there have been no decisions by the court or the Board in the related appeal or interference listed on page 4 of this Brief.